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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/624,571

07/23/2003

Alexander B. Maurer

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EXAMINER

VALENROD, YEVGENY

ART UNIT

PAPER NUMBER

1621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/624,571	<b>Applicant(s)</b> MAURER ET AL.	
	<b>Examiner</b> Yevgeny Valenrod	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11/1/06
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 19-31 is/are pending in the application.
- 4a) Of the above claim(s) 19,20 and 22-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

Objections to drawings 2 and 5 is withdrawn.

Rejection of claims 4 and 21 under 35 USC 112 is withdrawn in view of applicant's amendment.

Rejection of claims 1 and 4 under 35 USC 102 is withdrawn in view of applicant's amendment.

Rejection of claims 1-4 and under 35 USC 103 in view of Haslanger et al is maintained.

Text of the rejection has been modified to include claim 21.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frederick et al. (EP 0 200 377 B1).

Claims 1-4 of the instant application are directed to the compound of formula (I). Claims 2 and 3 further limit the scope of the generic claim by defining the ring type as cyclopentyl or cyclohexyl and identifying Z as CH.

#### *Scope of prior art*

Haslanger et al. teach N-Cyclohexyl-N-hydroxycyclohexaneacetamide (page 18, Example 19) and a method for treatment of allergies, comprising the said compound or

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other structurally related compounds (page 2, lines 1-13). The said compound has a cyclohexane ring and the variable Z (as defined in the instant claim 1) = CH.

*Ascertaining the difference between prior art and the instant claims*

In the compound taught by Haslanger et al., N-Cyclohexyl-N-hydroxycyclohexaneacetamide, the Nitrogen is substituted with a cyclohexyl substituent. The instant claims 1-4 limit the substitution at that position to a Hydrogen atom.

*Obviousness*

N-Cyclohexyl-N-hydroxycyclohexaneacetamide has utility as an anti-allergy agent (page 2 lines 1-13). The only difference between the instantly claimed compounds and N-Cyclohexyl-N-hydroxycyclohexaneacetamide is the N-cyclohexyl substituent in place of the N-Hydrogen in the instant claims. However, Haslanger et al. teach that the N-cyclohexyl substituent can be replaced with hydrogen (page 2, lines 5-13) and the resulting structure still will retain its anti allergenic properties, which renders the compounds of the instant application obvious over Haslanger et al.'s example 19 (page 18). One of ordinary skill in the art would therefore be motivated to make N-hydroxycyclohexaneacetamide, which is the N-Hydrogen substituted derivative of N-Cyclohexyl-N-hydroxycyclohexaneacetamide. There is reasonable expectation that the derivative would work as anti-allergy agent since Haslanger et al. have already suggested it (page2, line 13).

Concerning claim 21; It is well settled that the intended use of a composition or product (e.g. as a cosmetic composition) will not further limit claims drawn to a composition or product, so long as the prior art discloses the same composition

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comprising the same ingredients in an effective amount as instantly claimed. See, e.g., *Ex parte Masham*, 2 USPQ2d, 1647

*Response to applicants' remarks*

1) Applicant argues that claim 1 is not prima facie obvious.

Examiner respectfully disagrees with that statement. When  $X = CH_2$ ,  $p = 0$ ,  $Z = CH$  and  $n = 6$  membered ring, the only difference between instant claim 1 and example 19 in the reference is the presence of cyclohexyl substituent on the Nitrogen. The instant compound limited that substituent to a Hydrogen atom. Since Haslanger et al. describe cyclohexyl and hydrogen as equivalent substituents, the compound of claim 1 is prima facie obvious.

2) Applicant argues that unexpected and superior properties in inhibiting human histone deacetylase. Applicants' remarks lack side-by-side comparison of the compounds of the instant invention with those found in Haslanger et al. Applicants present no additional evidence to provide support for their claim to unexpected results.

The MPEP §2145 in connection with obviousness rejections says, "arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).

**Conclusion**

Claims 1-4 and 19-31 are pending.

Claims 19-20 and 22-31 are withdrawn.

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Claims 1-4 and 21 are rejected.

This office action is **non-final** because new grounds of rejection, particularly rejection of claim 21 under 35 USC 103 were not necessitated by the applicants' amendment.

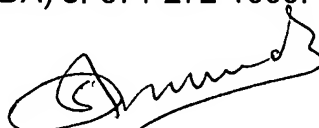
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yevgeny Valenrod whose telephone number is 571-272-9049. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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